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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/910,716 | 07/24/2001 | Hiroaki Harada | 1344.1071 | 1801 |

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT PAPER NUMBER

3626

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/910,716 | | HARADA ET AL. | |
| | Examiner | | Art Unit | |
| | Luke Gilligan | | 3626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of claims 1-12 in the reply filed on 1/18/06 is acknowledged. The traversal is on the ground(s) that because claims 1-12 and 13-19 are so closely related, there would not be an undue burden on the Examiner to examine both groups. This is not found persuasive because the two groups are directed to two distinct inventions, wherein the search for each group would not be required for the other. In fact, it is respectfully submitted that the two groups of claims have very little in common with one another other than their preambles. The Examiner agrees with Applicants that both groups of claims recite "insurance task processing" in their preambles, but the bodies of the claims are distinct from each other. Claims 1-12 recite limitations that are directed to distributing solicitation-to-insurance information based on monitoring electronic information within a computer network, whereas claims 13-19 recite limitations directed to encrypting information within an electronic network without any actual insurance processing. Although there may be some prior art references that include features for both of these distinct invention, it is respectfully submitted that the search for the features of each group would not be required for the other.
2. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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5. Claim 8 is directed to a "solicitation-judging function" and a "distributing function." These are computer programs that are not tangibly embodied on any computer readable medium.

Such computer programs are directed to descriptive material because they do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.

Therefore, claim 8 is directed to non-statutory subject matter.

6. Similarly, claim 9 is directed to an "input function," a "transmitting function," and a "receiving function." As described above, such computer programs are directed to descriptive material and, accordingly, are non-statutory.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 5-7, 9, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 3 recites the phrase "accident related to the electronic commerce" in the last line. Since there is no previous recitation of any "electronic commerce," there is insufficient antecedent basis for this limitation in the claim.

10. Claim 5 recites the phrase "the trading price included in the electronic information" in the fifth line. As noted above, there is no previous recitation of any "electronic commerce." There is also no previous recitation of a "trading price." Therefore, there is insufficient antecedent basis for this limitation in the claim.

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11. Claims 6, 9, and 12 recite the phrase "transaction related to the electronic commerce."

Since there is no previous recitation of any "electronic commerce," there is insufficient antecedent basis for this limitation in the claims.

12. Claim 7 depends from claim 6 and is rejected for the same reasons through dependency.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(e) as being anticipated by

DiMattina, U.S. Patent No. 6,405,177

15. As per claim 1, DiMattina teaches an insurance task processing method comprising: a solicitation-judging step for monitoring electronic information distributed within a computer network to judge whether or not a solicitation-related keyword as a clue of solicitation-to-insurance is included in said electronic information (see column 3, lines 56-58, the Examiner interprets the data regarding items a purchaser wishes to buy to be a form of "keyword" as recited in the claim); and a distributing step for distributing solicitation-to-insurance information to at least one of involved parties having exchanged the electronic information with each other, when said solicitation-related keyword is judged to be included in the electronic information (see column 3, line 58 – column 4, line 3).

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16. As per claim 2, DiMattina teaches the method of claim 1 as described above. DiMattina further teaches said distributing step distributes the solicitation-to-insurance information to the involved party when the involved party has not yet subscribed to insurance (see column 3, line 58 – column 4, line 3, since the insurance is offered for the particular transaction, the involved party has not yet subscribed to insurance).

17. As per claim 3, DiMattina teaches the method of claim 2 as described above. DiMattina further teaches said distributing step distributes the solicitation-to-insurance information to the involved party even when the involved party has already subscribed to insurance, if the insurance is invalid, or if the involved party has experienced an encounter with an accident related to the electronic commerce in the past (see column 3, line 58 – column 4, line 3, since DiMattina does not give any restrictions on when the insurance information is distributed, it would still be distributed under these conditions).

18. As per claim 4, DiMattina teaches the method of claim 1 as described above. DiMattina further teaches said distributing step distributes the solicitation-to-insurance information from an insurer selected corresponding to the contents of the electronic information (see column 3, lines 47-55).

19. As per claim 6, DiMattina teaches an insurance task processing method comprising: an input step for inputting transactional information in a transaction related to electronic commerce (see column 3, lines 56-58); a transmitting step for transmitting the input transactional information (see column 3, lines 56-58); and a receiving step for receiving solicitation-to-insurance information transmitted from a server of an insurer, when a solicitation-related keyword as a clue of solicitation-to-insurance is included in said transmitted transactional information (see column 3, line 58 – column 4, line 3).

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20. As per claim 7, DiMattina teaches the method of claim 6 as described above. DiMattina further teaches a transaction judging step for judging whether or not a transactional keyword has been included in said input transactional information (see column 3, line 56-58, the Examiner interprets the data regarding items a purchaser wishes to buy to be a form of “keyword” as recited in the claim); and a risk notifying step for notifying a risk related to the electronic commerce, when said transactional keyword is judged to be included in the transactional information (see column 3, line 58 – column 4, line 3, the Examiner interprets the “guarantees” to be a form of notification of risk related to the electronic commerce).

21. Claims 8, 10, and 11 recite substantially similar program, computer medium, and system limitations to method claim 1 and, as such, are rejected for similar reasons as given above.

22. Claims 9 and 12 recite substantially similar program and system limitations to method claim 1 and, as such, are rejected for similar reasons as given above.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiMattina, U.S. Patent No. 6,405,177 in view of Margoscini et al., U.S. Patent no. 7,003,482.

25. As per claim 5, DiMattina teaches the method of claim 1 as described above. DiMattina further teaches an insurance premium information receiving step for receiving insurance premium information which has been calculated corresponding to a price included in the

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electronic information (see column 5, lines 23-26); a sum calculating step for calculating the sum of the insurance premium indicated by the received insurance premium information and the price (see column 5, lines 26-29); and a presenting step for presenting the calculated insurance premium and the calculated sum to both of the involved parties (see column 4, lines 14-17 and column 5, lines 44-50).

26. DiMattina does not explicitly teach the insurance premium information is calculated based on a discount insurance premium rate. However, Margoscin teaches a business middleware system for implementing business policy changes including implementing insurance premium discounts (see column 11, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of DiMattina. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of easily implementing business policy changes, such as implanting insurance premium discounts (see column 2, lines 34-41).

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Dickinson teaches a system that offers insurance for electronic authentication.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

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29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/31/06


C. LUKE GILIGAN
PATENT EXAMINER